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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/228,658	01/12/1999	HANS PRINZING	P17233	8270

7055 7590 07/06/2004

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/228,658

Applicant(s)

PRINZING ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-19 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-19 and 22-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 23rd, 2004 has been entered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 4-19, 22-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has amended claim 1, to include "an electronic control that adjusts the pressure differential". However, while the claims appear to be enabled for "line force correction procedures" to be input by electronic control". The scope of this enablement does not appear to extend to the means by which the pressure differential is adjusted. On page 11, lines 18-19, it is clearly stated that the adjustment device, which is

Art Unit: 1731

arranged to adjust the pressure differential, may be adjusted "mechanically, hydraulically, pneumatically, manually, by remote control, at the site, at a control position, and/or in a process guided manner, as is conventional". However, there does not appear to be language that enables claims having a scope which includes "an electronic control that adjust the pressure differential". It is requested that this language be cancelled from the claim recitation.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 4-19, and 22-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, Applicant has recited an "adjustment device" that adjusts the pressure differential, but has also recited, in the same claim, "an electronic control that adjusts the pressure differential". It is not clear whether the "adjustment device" or the "electronic control", or both, performs the function of adjusting the pressure differential. Since the Examiner does not believe that it was intended that both "elements" perform this function, it will be assumed, for examination purposes, that Applicant intends to recite language such as the following: "said adjustment device, comprising an electronic control, adjusts the pressure differential". Clarification and/or correction is requested.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 4-19 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of Bentele et al (US. Pat. No. 5,788,817) in view of EP 752,495.

Bentele et al claims a roll press for the treatment of a web of material which includes: a first press roll (corresponding to the claimed "shoe press unit") with a first support element having a concave support surface for defining a wide press nip (corresponding to the claimed "press nip"), including a very flexible shell (corresponding to the claimed "flexible press belt/jacket") and a fixed support (corresponding to the claimed "non-rotating carrier") around which the first shell rotates; a backing roll (corresponding to the claimed "counter roll") with a second support element having a respective second rotatable roll shell (corresponding to the claimed "roll jacket") including a second fixed support (corresponding to the claimed "second non-rotating carrier") around which the second roll shell is rotatable, and being mounted at its ends

Art Unit: 1731

in non-displaceable manner (corresponding to the claimed "deflection compensation roll"); a third roll; and a roll nip formed between the backing roll and the third roll. The backing roll is axially increasingly bent in its axially central region toward the third roll (corresponding to the claimed "counter roll....being cambered"). The roll press assembly has a second support element which is oriented so that the direction of action (corresponding to the claimed "action plane") is slightly inclined by an angle which is between 2 and 15 degrees and/or between 4 and 8 degrees. The direction of action of the second support element begins at a position that is axial center of the second roll (corresponding to the claimed "second support element of the counter roll coinciding with ...the at least one first support element").

While Bentele et al may not claim a common pressure fluid line arranged to generate internal pressures by the first and second support elements; an adjustment device/variably adjustable valve/control device arranged to change a pressure differential between said internal pressures generated; first and second support elements being pressure fluid-actuated, said elements being connected to a common pressure fluid line; and pressure-active surfaces of one support element being "not equal" to second pressure active surfaces of the first support element of the shoe press unit, EP 752,495 discloses a shoe press device for treating a paper web having a shoe press roll comprising support elements, which press against a sag adjustment roll also having support elements which are smaller in their pressure areas than the support elements of the shoe press (corresponding to the claimed "pressure-active surfaces...being not-equal"). Both the shoe press and sag adjustment roll support

Art Unit: 1731

elements are fed with pressurized hydraulic liquid (corresponding to the claimed "fluid actuated") from a common pressure agent source. Various control devices (corresponding to the claimed "pressure reduction device/ adjustment device/ variably adjustable valve/control device") can be provided such that different respective pressures may be applied to the support elements of both shoe press roll and sag adjustment roll according to the requirements for dewatering a particular web (see col. 4, lines 9-15; col. 5, lines 1-10; see abstract and figs. 1 and 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the claimed invention of Bentele et al by adding the fluid-actuated support elements, pressure adjustment/control means, and first and second support elements of different area/number of EP 752,495 in order to control the pressure to the first and second roll support elements which would advantageously allow for a variation of the distribution of the pressing force, as desired, over the width of the paper web as taught in EP 752,495 (col. 1, lines 38-45). And while Bentele modified by EP 752,495 may not state that the control device which is arranged to change a pressure differential is an "electronic control", it follows that this would have been a conventional device to utilize to adjust said pressure differential since an electronic control device is one of several conventional means (including mechanical, pneumatical, hydraulic, etc.) by which to facilitate operations so that such actions do not have to be performed manually, and can be implemented in a more accurate and precise manner. Further, while Bentele modified by EP 752,495 may not specifically state that the control devices – which correspond to the claimed "adjustment device" - are structured to adjust the pressure

Art Unit: 1731

differential as a function of either a line force in the roll nip by predeterminable characteristic curves or line force correction procedures for the roll nip, wherein said correction procedures are input by electronic means and produced by corresponding signals of a process guidance system, absent any indication to the contrary, the control devices of Bentele modified by EP 752,495 would be structurally capable of performing the intended pressure changes as a function of either concept, as these procedures for adjusting pressure is conventional in the art (as is even admitted by Applicant in the instant specification).

Also, while Bentele modified by EP 752,495 may not specifically recite that the "adjusting/adjustment of the pressure differential provides cross-section corrections in the roll nip", it follows that adjusting/adjustment of the pressure differential in the device of the combined references would obviously result in said cross-section corrections in the roll nip, since said function would appear to flow naturally from the operation of the apparatus of Bentele modified by EP 752,495 because, namely, this apparatus has all the structural limitations of the instant claims. Therefore, the resulting "function" of "cross-section corrections in the roll nip" would, absent any indication by Applicant to the contrary, appear to logically result from utilizing the Bentele / EP 752,495 device.

Lastly, regarding claims 5-12, 18-19, and 22-23, these claims are comprised wholly of language that imparts *method*, rather than *structural*, limitations to the claims. Applicant is reminded that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function; and that "apparatus claims cover what a device *is*, not what a device *does*". (See MPEP 2114.) Therefore, only the

Art Unit: 1731

recitation in the above claims which impart structural limitations have been examined over the prior art.

7. Claim 25 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of Bentele et al (U.S. Patent No. 5,788,817) in view of EP 752, 495, further in view of Smook (*Handbook for Pulp & Paper Technologists, 2nd Ed.*).

This claim differs from the claims of Bentele et al modified by EP 752,495 because of language that recites third and fourth rolls (in addition to the counter roll) being cambered. However, as disclosed in Smook, cambering of all press rolls involved in papermachine pressing operations would have been obvious to one of ordinary skill in the art because cambering, or "crowning" of press rolls, is a necessary and conventional practice in the papermaking art that is performed in order to achieve a uniform pressure profile across the contacting face of the press roll (page 253, 2nd paragraph).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4-19, and 33 are rejected under 35 U.S.C. 103(a) as being obvious over Bentele et al (US. Pat. No. 5,788,817) in view of EP 752,495.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Bentele et al discloses a roll press for the treatment of a web of material which includes: a first press roll (corresponding to the claimed "shoe press unit") with a first support element having a concave support surface for defining a wide press nip (corresponding to the claimed "press nip"), including a very flexible shell (corresponding to the claimed "flexible press belt/jacket") and a fixed support (corresponding to the claimed "non-rotating carrier") around which the first shell rotates; a backing roll

Art Unit: 1731

(corresponding to the claimed "counter roll") with a second support element having a respective second rotatable roll shell (corresponding to the claimed "roll jacket") including a second fixed support (corresponding to the claimed "second non-rotating carrier") around which the second roll shell is rotatable, and being mounted at its ends in non-displaceable manner (corresponding to the claimed "deflection compensation roll"); a third roll; and a roll nip formed between the backing roll and the third roll. The backing roll is axially increasingly bent in its axially central region toward the third roll (corresponding to the claimed "counter roll....being cambered"). The roll press assembly has a second support element which is oriented so that the direction of action (corresponding to the claimed "action plane") is slightly inclined by an angle which is between 2 and 15 degrees and/or between 4 and 8 degrees. The direction of action of the second support element begins at a position that is axial center of the second roll (corresponding to the claimed "second support element of the counter roll coinciding with ...the at least one first support element") (see col. 3, line 34- col. 5, line 54; see abstract and figs).

While Bentele et al may not disclose a common pressure fluid line arranged to generate internal pressures by the first and second support elements; an adjustment device/variably adjustable valve/control device arranged to change a pressure differential between said internal pressures generated; first and second support elements being pressure fluid-actuated, said elements being connected to a common pressure fluid line; and pressure-active surfaces of one support element being "not equal" to second pressure active surfaces of the first support element of the shoe press

Art Unit: 1731

unit, EP 752,495 discloses a shoe press device for treating a paper web having a shoe press roll comprising support elements, which press against a sag adjustment roll also having support elements which are smaller in their pressure areas than the support elements of the shoe press (corresponding to the claimed "pressure-active surfaces...being not-equal"). Both the shoe press and sag adjustment roll support elements are fed with pressurized hydraulic liquid (corresponding to the claimed "fluid actuated") from a common pressure agent source. Various control devices (corresponding to the claimed "pressure reduction device/ adjustment device/ variably adjustable valve/control device") can be provided such that different respective pressures may be applied to the support elements of both shoe press roll and sag adjustment roll according to the requirements for dewatering a particular web (see col. 4, lines 9-15; col. 5, lines 1-10; see abstract and figs. 1 and 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the claimed invention of Bentele et al by adding the fluid-actuated support elements, pressure adjustment/control means, and first and second support elements of different area/number of EP 752,495 in order to control the pressure to the first and second roll support elements which would advantageously allow for a variation of the distribution of the pressing force, as desired, over the width of the paper web as taught in EP 752,495 (col. 1, lines 38-45) . And while Bentele modified by EP 752,495 may not state that the control device which is arranged to change a pressure differential is an "electronic control", it follows that this would have been a conventional device to utilize to adjust said pressure differential since an electronic control device is one of several

Art Unit: 1731

conventional means (including mechanical, pneumatical, hydraulic, etc.) by which to facilitate operations so that such actions do not have to be performed manually, and can be implemented in a more accurate and precise manner. Further, while Bentele modified by EP 752,495 may not specifically state that the control devices – which correspond to the claimed “adjustment device” - are structured to adjust the pressure differential as a function of either a line force in the roll nip by predeterminable characteristic curves or line force correction procedures for the roll nip, wherein said correction procedures are input by electronic means and produced by corresponding signals of a process guidance system, absent any indication to the contrary, the control devices of Bentele et al modified by EP 752,495 would be structurally capable of performing the intended pressure changes as a function of either concept, as these procedures for adjusting pressure are conventional in the art (as is even admitted by Applicant in the instant specification).

Also, while Bentele modified by EP 752,495 may not specifically recite that the “adjusting/adjustment of the pressure differential provides cross-section corrections in the roll nip”, it follows that adjusting/adjustment of the pressure differential in the device of the combined references would obviously result in said cross-section corrections in the roll nip, since said function would appear to flow naturally from the operation of the apparatus of Bentele modified by EP 752,495 because, namely, this apparatus has all the structural limitations of the instant claims. Therefore, the resulting “function” of “cross-section corrections in the roll nip” would, absent any indication by Applicant to the contrary, appear to logically result from utilizing the Bentele / EP 752,495 device.

Lastly, regarding claims 5-12, 18-19, and 22-23, these claims are comprised wholly of language that imparts *method*, rather than *structural*, limitations to the claims. Applicant is reminded that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function; and that "apparatus claims cover what a device *is*, not what a device *does*". (See MPEP 2114.) Therefore, only the recitation in the above claims which impart structural limitations have been examined over the prior art.

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bentele et al (U.S. Patent No. 5,788,817) in view of EP 752, 495, further in view of Smook (*Handbook for Pulp & Paper Technologists, 2nd Ed.*).

This claim differs from the claims of Bentele et al modified by EP 752,495 because of language that recites third and fourth rolls (in addition to the counter roll) being cambered. However, as disclosed in Smook, cambering of all press rolls involved in papermachine pressing operations would have been obvious to one of ordinary skill in the art because cambering, or "crowning" of press rolls, is a necessary and conventional practice in the papermaking art that is performed in order to achieve a uniform pressure profile across the contacting face of the press roll (page 253, 2nd paragraph).

11. Claims 1, 4-19, 22-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 195 20 443 in view of EP 752,495.

DE 195 20 443 discloses a roll press for the treatment of a web of material which includes: a first press roll (corresponding to the claimed "shoe press unit") with a first

Art Unit: 1731

support element having a concave support surface for defining a wide press nip (corresponding to the claimed "press nip"), including a very flexible shell (corresponding to the claimed "flexible press belt/jacket") and a fixed support (corresponding to the claimed "non-rotating carrier") around which the first shell rotates; a backing roll (corresponding to the claimed "counter roll") with a second support element having a respective second rotatable roll shell (corresponding to the claimed "roll jacket") including a second fixed support (corresponding to the claimed "second non-rotating carrier") around which the second roll shell is rotatable, and being mounted at its ends in non-displaceable manner (corresponding to the claimed "deflection compensation roll"); a third roll; and a roll nip formed between the backing roll and the third roll. The backing roll is axially increasingly bent in its axially central region toward the third roll (corresponding to the claimed "counter roll....being cambered"). The roll press assembly has a second support element which is oriented so that the direction of action (corresponding to the claimed "action plane") is slightly inclined by an angle which is between 2 and 15 degrees and/or between 4 and 8 degrees. The direction of action of the second support element begins at a position that is axial center of the second roll (corresponding to the claimed "second support element of the counter roll coinciding with ...the at least one first support element") (cols. 1,2 and 3; see fig. 1).

While DE 195 20 443 may not disclose an adjustment device/variably adjustable valve/control device arranged to change a pressure differential between said internal pressures generated; and pressure-active surfaces of one support element being "not equal" to second pressure active surfaces of the first support element of the shoe press

Art Unit: 1731

unit, EP 752,495 discloses a shoe press device for treating a paper web having a shoe press roll comprising support elements, which press against a sag adjustment roll also having support elements which are smaller in their pressure areas than the support elements of the shoe press (corresponding to the claimed "pressure-active surfaces...being not-equal"). Both the shoe press and sag adjustment roll support elements are fed with pressurized hydraulic liquid (corresponding to the claimed "fluid actuated") from a common pressure agent source. Various control devices (corresponding to the claimed "pressure reduction device/ adjustment device/ variably adjustable valve/control device") can be provided such that different respective pressures may be applied to the support elements of both shoe press roll and sag adjustment roll according to the requirements for dewatering a particular web (see col. 4, lines 9-15; col. 5, lines 1-10; see abstract and figs. 1 and 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the claimed invention of DE 195 20 443 by adding the fluid-actuated support elements, pressure adjustment/control means, and first and second support elements of different area/number of EP 752,495 in order to control the pressure to the first and second roll support elements which would advantageously allow for a variation of the distribution of the pressing force, as desired, over the width of the paper web as taught in EP 752,495 (col. 1, lines 38-45). And while DE 195 20 443 modified by EP 752,495 may not state that the control device which is arranged to change a pressure differential is an "electronic control", it follows that this would have been a conventional device to utilize to adjust said pressure differential since an electronic control device is one of several

Art Unit: 1731

conventional means (including mechanical, pneumatical, hydraulic, etc.) by which to facilitate operations so that such actions do not have to be performed manually, and can be implemented in a more accurate and precise manner. Further, while DE 195 20 443 modified by EP 752,495 may not specifically state that the control devices – which correspond to the claimed “adjustment device” - are structured to adjust the pressure differential as a function of either a line force in the roll nip by predeterminable characteristic curves or line force correction procedures for the roll nip, wherein these are input by electronic means and produced by corresponding signals of a process guidance system, absent any indication to the contrary, the control devices of Bentele modified by EP 752,495 would be structurally capable of performing the intended pressure changes as a function of either concept, as these procedures for adjusting pressure are conventional in the art (as is even admitted by Applicant in the instant specification).

Also, while DE 195 20 443 modified by EP 752,495 may not specifically recite that the “adjusting/adjustment of the pressure differential provides cross-section corrections in the roll nip”, it follows that adjusting/adjustment of the pressure differential in the device of the combined references would obviously result in said cross-section corrections in the roll nip, since said function would appear to flow naturally from the operation of the apparatus of DE 195 20 443 modified by EP 752,495 because, namely, this apparatus has all the structural limitations of the instant claims. Therefore, the resulting “function” of “cross-section corrections in the roll nip” would, absent any

Art Unit: 1731

indication by Applicant to the contrary, appear to logically result from utilizing the DE 195 20 443 / EP 752,495 device.

Lastly, regarding claims 5-12, 18-19, and 22-23, these claims are comprised wholly of language that imparts *method*, rather than *structural*, limitations to the claims. Applicant is reminded that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function; and that "apparatus claims cover what a device *is*, not what a device *does*". (See MPEP 2114.) Therefore, only the recitation in claims 1-32 which impart structural limitations have been examined over the prior art.

12. Claim 25 is rejected under 35 U.S.C. 103(a) as being obvious over DE 195 20 443 in view of EP 752, 495, further in view of Smook (*Handbook for Pulp & Paper Technologists, 2nd Ed.*).

This claim differs from the claims of Bentele et al modified by EP 752,495 because of language that recites third and fourth rolls (in addition to the counter roll) being cambered. However, as disclosed in Smook, cambering of all press rolls involved in papermachine pressing operations would have been obvious to one of ordinary skill in the art because cambering, or "crowning" of press rolls, is a necessary and conventional practice in the papermaking art that is performed in order to achieve a uniform pressure profile across the contacting face of the press roll (page 253, 2nd paragraph).

Response to Arguments


13. Applicant's arguments filed on March 23, 2004 have been fully considered but they are not persuasive. Said arguments are believed to have been adequately addressed in the above rejections over the prior art, specifically paragraphs 4, 7 and 9.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dionne A. Walls
Primary Examiner
Art Unit 1731

June 30, 2004